

REMARKS

In the Office Action mailed February 10, 2004, the Examiner rejected claims 23-32 and 34-45. Claims 23-26, 28-32 and 34-52 are now pending in the application. Claims 23, 31, 37-43 have been amended, claims 27, 32 and 33 have been cancelled and claims 46-52 have been added. By way of the foregoing amendments and the markings to show changes, and the discussion contained herein, Applicant is of the opinion that claims 23-26, 28-32 and 34-52 are now in condition for allowance. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Allowable Subject Matter

Applicant would first like to thank the Examiner for his acknowledgment of the allowable subject matter contained in objected claim 33, wherein the claim would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have rewritten claim 31 to include the subject matter of claims 32 and 33 and have included dependent claims 46-52 thereon, presently additional allowable subject matter.

Impermissible use of U.S. Patent No. 3,926,904 to Scola

The Examiner rejected all of the claims based on combinations including U.S. Patent No. 3,926,904 to Scola, a curable crack-resistant epoxy resin. At a minimum, Applicant is of the opinion that use of this reference is impermissible because there is a lack of motivation to combine this reference with any other references cited thus far, as required by *In re Rouffet*¹ to formulate a proper prima facie case of Obviousness. More specifically, none of the references cited teach the use of adhesives as the sole or even a contributing means for securing an oil pan to an engine. There is no motivation found in Ritter², nor would it have been obvious to one skilled in the art, to replace the mechanical means for attaching the oil pan with

¹ *In re Rouffet*¹, 149 F3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)

² Applicants have not fully translated the WO 00/43644 patent and are basing this opinion on the small portions that have been translated and the English translation of the title and abstract of the patent.

an adhesive, particularly of the characteristics recited in the claims. Furthermore, the Examiner does not identify how Scola provides any application of adhesive, especially an adhesive to join a plastic and metal and endure the operating conditions of an engine, including the exposure to hydrocarbons. As known, the bonding ability of an adhesive can vary drastically and unpredictably depending on material selected with certain combinations incapable of providing a bond. As such, a prima facie case of obviousness cannot be formed with Scola. Notwithstanding, applicants have amended the claims to more clearly recite the features of the present invention, as described herein.

Response to Rejections based on 35 USC §103

Independent claims 23 and 31 were rejected under 35 USC §103 based on U.S. Patent No. 4,498,433 to Ogawa (Ogawa patent) in view of U.S. Patent No. 3,926,904 to Scola (Scola patent) and based on WO 00/43644 to Ritter (Ritter patent) in view of the Scola patent. Independent claim 37 was rejected under 35 USC §103 based on the Ritter patent in view of the Scola patent. The remaining claims, which are dependent claims to above Independent claims, were rejected, except claim 33 as described above, under 35 USC §103 based on the Scola patent in view of the Ritter patent and/or Ogawa patent and/or U.S. Patent No. 4,374,717 to Drauglis et al. (Drauglis patent) and/or U.S. Patent No. 5,250,629 to Tani et al. (Tani patent) and/or JP 404277399A to Okabe (Okabe reference). For the reasons set out below, these rejections are rendered moot.

Applicant does not acquiesce to the rejection of claim 23 formulated by the Examiner. Notwithstanding, Applicant has amended claim 23 to recite an example of a unique feature of the present invention particularly advantageous to the mounting of an oil pan to an engine, namely "a plurality of integrally formed clips adapted to align the oil pan with the engine component". None of the references cited thus far teaches this feature particularly in the combination as a whole claimed by the applicants. The Ritter patent merely teaches a flange, which apparently travels about the periphery of the oil pan. As such, the Examiner's rejection to claim 23 has been rendered moot and Applicant is of the opinion that claim 23 is in condition for

allowance. Likewise, claims 24-26 and 28-32, which are dependent upon claim 23 are also believed to be allowable.

For the same reasons set forth below in the discussion of Objected claims 33, claim 31 is now believed to be allowable because, per the Examiner's suggestion, it contains limitations specified in dependent claims 33 and 32. Likewise, claims 34-36 and 46-52, which are dependent upon claim 31, are also believed to be allowable.

To expedite prosecution, without acquiescence in the rejection of claim 37 formulated by the Examiner, Applicant has amended claim 37 particularly to include that the cure-on-demand adhesive "is able to withstand exposure to hydrocarbon materials and resists curing until after the first and second mating surfaces are joined". None of the references cited thus far teaches this feature, particularly in the combination as claimed by Applicant. It appears that the Scola patent teaches that the curing agent may be added to the other ingredients of the adhesive just prior to its application. However, the Examiner has not identified where in Scola there is a teaching of an adhesive that "is able to withstand exposure to hydrocarbon materials and resists curing until after the first and second mating surfaces are joined". As such, the Examiner's rejection to claim 37 has been rendered moot and Applicant is of the opinion that claim 37 is in condition for allowance. Likewise, claims 38-45, which are dependent upon claim 37 are also believed to be allowable.

Objection to claim 33

Applicant has cancelled claim 33. As such, this objection is rendered moot. Notwithstanding, Applicant has, per Examiners suggestion, included the subject matter of claims 33, and necessarily claim 32, into claim 31 to form an allowable claim. Applicants have further amended claim 31 to remove the limitation of the "resulting joint [having] a strength greater than the strength of said molded plastic oil pan" and have include the following underlined portion: "wherein said one or more integrally formed clips are adapted to align said molded plastic oil pan with said engine component when engaged with said one or more cutout portions formed on said engine component". Since, none of prior art references teaches this combination, Applicant is of the opinion that claim 31 is now in condition for allowance.

By amending the application, the Applicant does not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicant intends to file a continuation application to pursue the breadth of the claims as filed. Applicant believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicant has recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicant from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled.

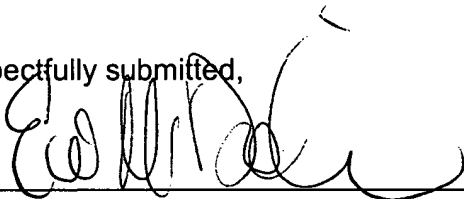
CONCLUSIONS

In view of Applicant's amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicant submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

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Respectfully submitted,



Eric M. Dobrusin
Registration No. 33,867
DOBRUSIN & THENNISCH PC
401 S. Old Woodward Ave., Ste. 311
Birmingham, MI 48009
(248) 593-9900

Customer No. 25215